

REMARKS

Claims 1-6 and 11-37 are currently pending.

In the Office Action mailed on March 25, 2004 ("Office Action"), the Examiner rejected claim 29 under 35 U.S.C. § 112, first paragraph, for failing to be enabled by a specification which would enable one of ordinary skill in the art to make the invention; rejected claim 29 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter for which the Applicant regards as the invention; rejected claims 1-6, 11-31, 34-35, and 37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,212,684 to MacNamee et al. (hereinafter "MacNamee"); and rejected claims 32, 33, and 36 under 35 U.S.C. § 103(a) as being unpatentable over MacNamee and further in view of Applicant's admitted prior art ("AAPA").

By this amendment, Applicant amends claim 29 to overcome the § 112, first paragraph, rejection by more appropriately defining the invention.

Concerning the rejection under 35 U.S.C. § 112, first paragraph, the Examiner indicates that when "only one base station (Csa) is used and another (third) party tries to form a communication link with the station (Csa), the fixed station must experience a failure of synchronization page 5, lines 9+." (Office Action, p. 2, internal quotations omitted). However, a careful reading of the passage cited by the Examiner reveals that the failure of synchronization is due to a change (or switch) in rates from 64 Kbps to 32 Kbps, not the use of a single base station as wrongly alleged by the Examiner. (Specification, p. 4, l. 20 - p. 5, l. 13). For at least this reason, the rejection of claim 29 under 35 U.S.C. § 112, first paragraph, should be withdrawn.

Concerning the rejection under 35 U.S.C. § 112, second paragraph, Applicant submits that the amendment to claim 29 obviate the basis for the Examiner's rejection. Therefore, the rejection of claim 29 under 35 U.S.C. § 112, second paragraph, should be withdrawn.

The Examiner rejected claims 1-6, 11-31, 34-35, and 37 under 35 U.S.C. § 103(a) as being unpatentable over MacNamee. Applicant respectfully traverses the rejection for the following reasons.

Claim 1 recites a combination of elements including, *inter alia*, “notifying unit configured to notify a connected another communication apparatus of a number of usable channels based on a negotiation between the communication apparatus and a relay station being connected to the communication apparatus.”

The Examiner wrongly alleges that MacNamee FIG. 5 at 38 and 40 depicts the “notifying unit,” as recited in claim 1. Rather than the claim 1 “notifying unit,” MacNamee at FIG 5 merely depicts an antenna 40 and an RF section 38. (MacNamee FIG. 5 and col. 48-53). Indeed, nowhere does MacNamee disclose any structure that notifies another communication apparatus of the number of usable channels based on a negotiation between the communication apparatus and a relay station. At best, MacNamee is consistent with past approaches that either never changed data rate or unilaterally changed data rate—subsequently losing synchronization with another communication device, as described in the background of the invention section at page 7. For at least these reasons, MacNamee fails to disclose a combination including at least a “notifying unit configured to notify a connected another communication apparatus of a number of usable channels based on a negotiation between the

communication apparatus and a relay station being connected to the communication apparatus.” Moreover, the Examiner’s modifications to MacNamee fail to cure its deficiencies. Therefore, claim 1 is allowable over MacNamee, and the rejection of claim 1 and claims 2-4 and 19-22, at least by their dependency from claim 1, under 35 U.S.C. § 103(a) should be withdrawn.

Moreover, the Examiner acknowledges that MacNamee does not explicitly teach the claim 1 “selecting data based on the number of channels” at the other communication apparatus. Indeed, MacNamee merely depicts communications between a primary station 10 and a secondary station 13. As such, MacNamee fails to describe any type of negotiation with another communication device. However, the Examiner ignores the shortcomings of MacNamee and then appears to take Official Notice to fill such clear gaps in MacNamee. Applicant disagrees and submits that the Examiner appears to be improperly taking Official Notice with respect to the other communication apparatus. By taking Official Notice, the Examiner's statements are unsupported by factually-based evidence and constitute unsubstantiated generalizations of questionable relevance to Applicant’s claims. Applicant refers the Examiner to the February 21, 2002 Memorandum from USPTO Deputy Commissioner for Patent Examination Policy, Stephen G. Kunin, regarding "Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice" (“Memorandum”). In relevant part, the Memorandum states, "If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding." (Memorandum, p. 3). Should the Examiner

maintain the objection, Applicant submits that the Examiner must provide "the explicit basis on which the examiner regards the matter as subject to Official Notice and [allow Applicant] to challenge the assertion in the next reply after the Office Action in which the common knowledge statement was made" (*Id.* at 3, emphasis in original), or else withdraw the objection. Moreover, Applicant disagrees with the Examiner's apparent use of Official Notice with respect to claims 2-6, and 19-22, which depend from allowable claim 1. Absent a factual basis placed on the record for the Examiner's taking of Official Notice, the rejection under 35 U.S.C. § 103(a) of claim 1 and claims 2-5 and 19-22, by their dependency from allowable claim 1, should be withdrawn for this additional reason.

Furthermore, because MacNamee merely discloses a primary station 10 and a secondary station 13, MacNamee cannot possibly disclose or suggest at least the "selecting unit configured to select a communication rate based on the notifying number of channels and the detected number of useable channels" recited in claim 1. For this additional reason, claim 1 is allowable over MacNamee.

Independent claims 6, 23, and 28, although of different scope, include recitations similar to those of claim 1. Claims 11-18, 24-27, and 29 depend from claims 6, 23, and 28, respectively. For at least the reasons given above with respect to allowable claim 1, claims 6, 11-18, 23-29 are allowable over MacNamee, and the rejection of those claims under 35 U.S.C. § 103(a) should be withdrawn.

Claim 30 recites a combination of elements including, *inter alia*, "obtaining unit configured to obtain a first number of usable channels based on a first negotiation between the communication apparatus and a first base station being connected to the

communication apparatus.” Claim 31 recites a combination of elements including, *inter alia*, “obtaining unit configured to obtain a first number of usable channels based on a first negotiation between the communication apparatus and a first station of the network, the first station being connected to the communication apparatus.” Claim 34 recites a combination including, *inter alia*, “obtaining unit configured to obtain a first usable data rate based on a first negotiation between the communication apparatus and a first base station being connected to the communication apparatus.” Claim 35 recites a combination including, *inter alia*, “obtaining unit configured to obtain a first usable data rate based on a first negotiation between the communication apparatus and a first station of the network, the first station being connected to the communication apparatus.” Claim 37 recites a combination including, *inter alia*, “determining unit configured to determine a first usable data rate between the first communication apparatus and a first base station being connected to the first communication apparatus based on a total data rate of idle channels of the first base station.” For at least the reasons given above with respect to claim 1, MacNamee fails to disclose or suggest at least these elements of each of claims 30, 31, 34, 35, and 37. Moreover, the Examiner’s modifications to MacNamee fail to cure its deficiencies. Therefore, the rejection of claims 30, 31, 34, 35, and 37 under 35 U.S.C. § 103(a) should be withdrawn.

The Examiner rejected claims 32, 33, and 36 under 35 U.S.C. § 103(a) as being unpatentable over MacNamee and further in view of Applicant’s admitted prior art (“AAPA”).

Claim 32 recites a combination of steps including, for example, determining a first number of usable channels between the first communication apparatus and a first base station being connected to the first communication apparatus based on a number of idle channels of the first base station, and determining a second number of usable channels between the second communication apparatus and a second base station being connected to the second communication apparatus based on a number of idle channels of the second base station. Moreover, claim 32 recites the step of determining the communication rate based on the first number of usable channels and the second number of usable channels.

For at least the reasons given above with respect to claim 1, MacNamee fails to disclose or suggest the step of “determining a first number of usable channels between the first communication apparatus and a first base station being connected to the first communication apparatus based on a number of idle channels of the first base station,” as recited in claim 32. Moreover, AAPA fails to cure the deficiencies of MacNamee. Moreover, the Examiner acknowledges that MacNamee is completely silent with respect to “a communication apparatus at the opposite end” (Office Action, p. 3). As such, MacNamee fails to also disclose or suggest the claim 32 step of “determining a second number of usable channels between the second communication apparatus and a second base station.” Lastly, because MacNamee fails to disclose or suggest the use of a “second communication apparatus,” MacNamee cannot possibly teach or suggest the claim 32 step of “determining the communication rate based on the first number of usable channels and the second number of usable channels.” For at least these reasons, neither MacNamee nor AAPA discloses the combination of steps recited in

claim 32. Therefore, the rejection of claim 32 under 35 U.S.C. § 103(a) should be withdrawn for this additional reason.

Moreover, a *prima facie* case of obviousness has not been made by the Examiner. To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. §2143.03 (8th ed. 2001).) As noted above, neither MacNamee nor AAPA discloses or suggests each element recited in claim 32. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. For this second prong, the Examiner has merely used impermissible hindsight reasoning to reconstruct the MacNamee reference by merely stating that such a modification “provide[s] an optimum use of channel resources ... and provide[s] the best traffic resources.” (Office Action, p. 5). Third, a reasonable expectation of success must exist that the proposed modification will work for the intended purpose. Concerning this third prong, the Examiner has also failed to make any showing. Moreover, each of the *prima facie* obviousness requirements must be found in the prior art, and not be based on Applicant’s disclosure. (See M.P.E.P. § 2143 (8th ed. 2001).) Absent a showing by the Examiner, the rejection of claim § 103(a) should be withdrawn for this additional reason.

Claims 33 and 36, although of different scope, include recitations that are similar to those of claim 32. For at the reasons given above with respect to claim 32, the

rejection of claims 33 and 36 under 35 U.S.C. § 103(a) should be withdrawn for this additional reason.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

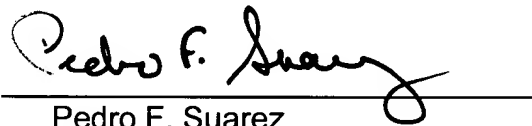
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 19, 2004

By: _____



Pedro F. Suarez
Reg. No. 45,895

677025 v1